

REMARKS

Reconsideration and allowance of the application are respectfully requested. Claims 29-61 were in the application, claims 29-61 have been cancelled, new claims 62-75 have been added.

The applicant recently retained new counsel to prosecute the application, and the undersigned has studied the cited art to develop the above presented new claims which are believed to distinguish from the cited art and which would also better protect the applicants invention. It is believed that new independent method claim 62 and new independent apparatus claim 68 do distinguish from the prior art as will be discussed further below.

New claim 62 clarifies several aspects of the applicants invention. First, the "service module" is one which is prefabricated in a factory, and has walls, a floor and a roof, as shown in Figs. 1 and 2, (though the roof may be removable for stacking, as shown in Fig. 6), having a specific size so as to have a length and height which corresponds to a transport container for ease of shipment. This is well described in the specification. "Service" relates to the building utilities, electrical, water, sewer, etc., as described in para 0038, which are provided in this module (with reference to the published application).

This is an important component, as the service module is not just a "core" assemble, but a full part of the building structure, which provides two functions:

- 1) acting as an anchor for the building, being the main component from which the rest of the building is assembled, using the various vertical and horizontal segments having sizes determined in correspondence therewith, and
- 2) being the focal point for the service connections referenced in the application.

To clarify the various elements, the horizontal segments are specified as either "roof" or "floor" segments, and the vertical segments as "wall", as this eased the description on the manner in which the building is assembled.

No new matter is believed to be involved in this amendment.

Claims 29, 30, 35, 39-41, 43-47, 50-52 and 56-61 were rejected as being obvious over Bigelow, U.S. Patent no. 4,327,529 in view of Bolt, U.S. Patent no. 3,103,709.

While the referenced claims have been cancelled, new claims 62-75 replace several of these claims and the rejection will be address by application to these new claims.

The Examiner alleged that Bigelow included many of the elements of previous claims 29 and 43, now claims 62 and 69. However, the Examiner admitted that Bigelow lacked the relative dimensional limitations regarding the module and segments, among other deficiencies. The Examiner then alleged that Bolt "presents a module of a size for container tarnsportation". This is incorrect.

Bolt fails to disclose at all any module, and certainly not a "service module" as claimed. Rather the entire specification in Bolt relates to a rectangular floor member, having at each end framing which folds down over the floor member. The reference to col. 2, lines 9-10 relates only to the flat folded configuration of the floor panels, and there is neither shown nor described a "service module" that is already assembled and which, when placed on the foundation, sets the size of the entire building assembled from the various horizontal and vertical segments as discussed. The service module thus is similar to a keystone, the one piece from which all the other componts are measured.

No such service module is found, taught, suggested or predictably found in Bolt. It should be pointed out as well that no such a service module with particular dimensions from which all other segments are measured is found in Bigelow. Bigelow does describe a core which will fit within a building, but the dimensions of the core have no criticality to the building built therefrom. As seen in Fig. 4 for example, the core is just one small component which fits within a container, and whose dimensions play no part in determining the building size.

In conducting an obviousness analysis, "[a] fact finder should be aware . . . of the distortion caused by hindsight bias and must be cautious of arguments

reliant upon ex post reasoning." KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1742, 167 L. Ed. 2d 705 (2007). This is because the genius of invention is often a combination of known elements that in hindsight seems preordained. In re Omeprazole Patent Litig., No. MDL 1291, 490 F. Supp. 2d 381, 2007 U.S. Dist. LEXIS 39670, at *400-01 (S.D.N.Y. May 31, 2007) (citation omitted) (quoting KSR, 127 S.Ct at 1742); see also Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138 (Fed. Cir. 1985), Raytheon Co. v. Roper Corp., 724 F.2d 951, 961 (Fed. Cir. 1983) (stating that "virtually every claimed invention is a combination of old elements"(Emphasis added)).

"It is not within the framework of 35 U.S.C. Section 103 to pick and choose from the prior art only so much as will support a holding of obviousness to the exclusion of other parts necessary for a full appreciation of what the prior art teaches or suggests, as hindsight is not the test. In re Wesslau, 353 F.2d 238 (CCPA 1965). The Examiner "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." In re Fine, 837 F.2d 1071, 1075, 5 U.S.P.Q.2D (BNA) 1596 (Fed. Cir. 1988).

The examiner must guard against reliance on "hindsight", best explained as follows:

The genius of invention is often a combination of known elements which in hindsight seems preordained. To prevent hindsight invalidation of patent claims, the law requires some "teaching, suggestion or reason" to combine cited references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 U.S.P.Q.2D (BNA) 1378, 1383 (Fed. Cir. 1997). When the art in question is relatively simple, as is the case here, the opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references need to be applied rigorously. See In re Dembiczak, 175 F.3d 994, 999, 50 U.S.P.Q.2D (BNA) 1614, 1617 (Fed. Cir. 1999), limited on other grounds by In re Gartside, 203 F.3d 1305, 53 U.S.P.Q.2D (BNA) 1769 (2000) (guarding against falling victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher). McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351, 60 U.S.P.Q.2D (BNA) 1001, 1008 (Fed. Cir. 2001).

Moreover, to support a conclusion that a claim would have been obvious, it must be established that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art. KSR, at 416-417.

With reference to both Bigelow and Bolt, neither patent discloses a service module as claimed in the applicants invention, nor the particular horizontal and vertical segments which are sized in correspondence thereto, and absent the structure of claims 62 and 69, certainly it is not possible to provide the structure nor functions achieved with the components of the applicants invention.

Relative to the goals of the invention, the building of Bigelow is clearly more complex and difficult to construct than the applicants invention, and the complete service module and dimensionally related segments make assembly proceed much more smoothly, efficiently and economically. The lack of any services in Bolt would by necessity take more time to construct as these would have to be provided "ad hoc", with a corresponding increase in time and expense. Consequently, in view of the above, new claims 62-75 are believed to be readily distinguishable from the prior art.

Claims 31, 32, 36-38, 42, 48, 49, 54 and 55 were rejected as being obvious over Bigelow in view of Bolt and further in view of Gregory.

The arguments above with reference to the primary and secondary references are equally applicable here.

Further, while Gregory discloses "modules" it should be understood that there is no discussion of the provision of a "service" module, and the dimensions of the module are not critical, in fact the size varies and so no horizontal or vertical segments are provided "having a width substantially corresponding to the height of the service module and a length substantially corresponding to the length of the

service module". (For example, see col. 6, l. 55-60). Consequently, the combination with Bigelow and Bolt does not lead one to a building where two "service" modules are placed in an end to end orientation, with the horizontal and vertical segments assembled thereto as claimed. Consequently, claims 63 and 73 which relate to the two service module embodiment are not rendered obvious over the cited art.

Based on the above amendments and remarks, reconsideration and allowance of the application are respectfully requested. However, should the examiner believe that direct contact with the applicant's attorney is necessary to advance the prosecution of the application, the examiner is invited to telephone the undersigned at the number given below.

Respectfully submitted,

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